Attorney Docket: 042846-0313440

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE PATENT APPLICATION OF:	ROUSE et al.
SERIAL NO.:	09/750,320
FILING DATE:	December 29, 2000
ART UNIT :	2618
EXAMINER	Yuwen Pan
FOR:	SYSTEM AND METHOD FOR PROVIDING WIRELESS DEVICE ACCESS

REPLY BRIEF UNDER 37 C.F.R. § 41.41

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Examiner's Answer mailed December 23, 2008 ("Answer"),

Appellants respectfully submit a Reply Brief pursuant to 37 C.F.R. § 41.41.

It is not believed that any fees are due in this case. However, the Director is

hereby authorized to charge any additional fees that may be due, or credit any

overpayment of same to Deposit Account No. 033975 **(Ref. No. 042846-0313440)**.

REQUIREMENTS OF 37 C.F.R. §41.41

I.   <u>37 C.F.R. § 41.37(c)(1)(iii) – STATUS OF CLAIMS</u>

<u>Pending</u>:   Claims 21, 22, 24-30, 32-39, and 41-44 are pending.

<u>Cancelled</u>:   Claims 1-20, 23, 31, and 40 have been cancelled without prejudice or disclaimer.

<u>Rejected</u>:   Claims 21, 22, 24-30, 32-39, and 41-44 stand rejected.

<u>Allowed</u>:   No claims have been allowed.

<u>On Appeal</u>:   The rejections of claims 21, 22, 24-30, 32-39, and 41-44 are appealed.

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II. 37 C.F.R. § 41.37(c)(1)(vi) – Grounds of Rejection to be Reviewed on Appeal.

Claims 21, 22, 25-30, 32-36, 37-39, and 42-44 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,633,759 to Kobayashi ("Kobayashi") in view of U.S. Patent No. 6,052,735 to Ulrich *et al.* ("Ulrich"), and claims 24 and 41 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kobayashi in view of Ulrich, and in further view of U.S. Patent No. 6,308,061 to Criss *et al.* ("Criss"). These rejections constitute legal error, and should be reversed upon review.

III.   37 C.F.R. § 41.37(c)(1)(vii) – ARGUMENT

For the sake of brevity, Appellants address below only the rejections of claims in which the Answer raised new issues or made mischaracterizations of the teachings of the references, the subject matter of the claims, and/or Appellants' positions that Appellants have not adequately addressed in the Appeal Brief. The exclusion from these Arguments of some of the rejections addressed specifically in the Arguments of the Appeal Brief should not be viewed as acquiescence on the part of Appellants. Instead, Appellants believe that the arguments provided in the Appeal Brief with respect to the rejections not addressed here are sufficient in showing legal error.

A.   CLAIMS 21 AND 38 (and their dependent claims).

The rejection of claims 21 and 38 (and their dependent claims) based on the cited sections of Kobayashi and Ulrich is legally erroneous at least because the Examiner has failed to present evidence demonstrating the *prima facie* obviousness of these claims. In particular, the Examiner has failed (1) to show that each and every feature of claims 21 and 38 is taught or suggested by Kobayashi and Ulrich, and (2) to provide evidence establishing that it would have been obvious to one of ordinary skill in the art to combine the teachings of Kobayashi and Ulrich in the manner proposed by the Examiner.

> 1.   **The Examiner Has Not Demonstrated That Kobayashi And Ulrich Teach Or Suggest All Of The Features Of The Claimed Invention.**

The Examiner has not provided evidence that the proposed combination of Kobayashi and Ulrich teaches or suggests all of the features of claims 21 and 38. For example, claims 21 and 38 recite *inter alia* the following features, which are not taught or suggested in the sections of Kobayashi and Ulrich relied on by the Examiner:

> ...formatting at least one application output associated with the at least one selected application actions <u>based on a profile of the wireless client device</u> and a user selection of one or more fields associated with the at least one file....

The Examiner acknowledges that Kobayashi fails to teach or suggest these features [Answer, p. 9]. In particular, the Examiner alleges that Kobayashi teaches the resizing and/or reorganization of data prior to transmission from a laptop computer to a mobile phone so that the data can be displayed on a mobile phone. The Examiner acknowledges that the rearranging of the data is to accommodate the display of a mobile phone generically, and not customized for a specific wireless client device "based on a profile of the wireless client device" [*id.*]. The Examiner alleges that this type of formatting based on a profile of a mobile device is taught by Ulrich [*id.*].

However, the formatting taught in Ulrich is not the same "type of formatting" allegedly described in Kobayashi, or recited in claims 21 and 38. As such, the disclosure of Ulrich does not provide a teaching of the features that are acknowledged by the Examiner as being missing from Kobayashi.

Claims 21 and 38 explicitly recite that the "at least one application output" to be formatted is "associated with the at least one selected application actions." Claims 21 and 38 further recite:

> ...the application action comprising at least one or more of
> opening at least one file within the server, closing at least one file
> within the server, editing at least one file within the server, or searching
> at least one file within the server....

In contrast to the recitations of claims 21 and 38, the formatting described in Ulrich is the electronic conversion of file formats. In particular, attachments to emails may be converted to different file formats before being automatically forwarded to a mobile device [Ulrich, c. 14, ll. 7-19]. This conversion is described as taking place without user interaction based on a user profile configured beforehand [*id.*]. The file formats of files attached to emails are converted so that the files can be opened and interacted with on a mobile device. This is notably different than the formatting recited in claims 21 and 38, and the formatting allegedly described in Kobayashi.

For example, the Examiner alleges that the conversion of file formats in Ulrich constitutes the "formatting at least one application output associated with the at least one selected application actions" recited in claims 21 and 38 because Ulrich includes the selection of an open file command [Answer, pp. 9 and 10 (*quoting* Ulrich, c. 12, l.

57-c. 13, l. 11)]. However, the open file command discussed in the cited section of Ulrich is the opening of an attachment file on the mobile device, not "opening at least one file <u>within the server</u>" as is recited of the "at least one selected application action" of claims 21 -38.

This distinction between the conversion of file formats for email attachments discussed in Ulrich and the "formatting" recited in claims 21 and 38 is significant because the "application actions" expressly recited in claims 21 and 38 as being performed "within the server" (opening, closing, editing, or searching) are actions associated with accessing the content within a file. As such, the formatting of the "application output" recited in claims 21 and 38 constitutes the formatting of information generated through server-side accessing and/or processing of <u>content</u> within the file that is interacted with on the server by the "application action." Since in the claimed invention file contents are accessed and formatted for display on a mobile device by the server, the processing and storage loads associated with these types of application actions are born by the server. By contrast, in the system of Ulrich the client bears the burden of storing complete attachment files, and of processing the files to enable access to the content contained therein.

Further, the Examiner contends that the reorganization of data prior to transmission to a mobile phone in Kobayashi teaches a process allegedly similar to the claimed "formatting" in which the contents of document files are rearranged for display on the mobile phone. Ulrich on the other hand, only teaches converting file formats of email attachments prior to transmitting the attachments in their entirety to the mobile device. As such, Ulrich does not provide a teaching of modifying the type of formatting described in Kobayashi to arrive at the features of claims 21 and 38 reproduced above.

Therefore, the specific combination of Kobayashi and Ulrich proposed by the Examiner, in which the conversion of electronic formats of files in Ulrich is substituted wholesale into the teachings of Kobayashi, fails to teach or suggest at least the features of claims 21 and 38 reproduced above. Further, the Examiner has not proposed any other combination of Kobayashi and Ulrich, and has not provided any evidence supporting the obviousness of any other combination of these references. Accordingly,

the rejection of claims 21 and 38 (and their dependent claims) based on the combination of Kobayashi and Ulrich proposed by the Examiner constitutes legal error and must be reversed.

> 2.   **The Examiner Has Not Established That It Would Have Been Obvious To Combine Kobayashi And Ulrich In The Proposed Manner.**

The rejection of claims 21 and 38 based on the proposed combination of Kobayashi and Ulrich constitutes legal error at least because the Examiner has not provided any evidence or reasoning that properly supports the legal conclusion of the alleged obviousness of the proposed combination.

The proper analysis involved in the legal determination of "obviousness" is flexible, and provides for the use of common sense in applying the references to the claimed invention [*KSR v. Teleflex, Inc.*, 127 S.Ct. 1727, 1739 and 1742]. However, determinations of obviousness cannot be sustained on conclusory statements, but require articulated reasoning that provides a "rational underpinning" supporting the legal conclusion of obviousness [*id.* at 1740-1741].

In support of the combination of Kobayashi, the Examiner has presented a new reasoning behind the proposed combination in the Answer [p. 10]. In particular, the Examiner contends:

> It would have been obvious... to combine the teaching of Ulrich with Kobayashi's system so that the received data would be compatible with the mobile device and viewable by the user and less information to be transferred to the mobile device [*id.*].

Under *KSR*, an express motivation to combine or modify references is not necessary for a conclusion of obviousness. However, at least some evidence of obviousness is required [1740-1741]. In the present case, the alleged motivation reproduced above is the only alleged basis that the Examiner has provided for the proposed combination. Thus, in this case the correct focus in addressing the alleged obviousness of the proposed combination is on whether there is sufficient evidence to support the Examiner's allegation regarding motivation.

The Examiner alleges that Kobayashi teaches the reorganization of the content in files being manipulated in a laptop computer to facilitate display of the content on mobile devices initially intended for display on the laptop computer [Kobayashi, c. 8, l. 29-c. 9, l. 13]. The only data transmitted from the personal computer in Kobayashi to the mobile device is "display data" (also referred to as "screen data"), not files attached to email for access and manipulation on the mobile device [*id.*].

By contrast, the sections of Ulrich relied on by the Examiner are relevant to forwarding emails with attached files to a mobile device. Ulrich teaches that in order for the content of the files to be accessed and/or manipulated on the mobile device, the file format of the attached files should be converted to a file format supported by the mobile device (e.g., supported by the software available on the mobile device) [c. 13, l. 44-c. 14, l. 31].

The Examiner alleges that ensuring compatibility of the transmitted data to the mobile devices would have motivated one of ordinary skill in the art to incorporate the teachings of Ulrich into the system of Kobayashi. In reality, this type of software compatibility is irrelevant in the system of Kobayashi because in Kobayashi the functionality attributed to the mobile phone and laptop computer would require dedicated software applications designed specifically to provide the mobile phone and laptop computer with the capabilities described. Kobayashi does not even discuss software compatibility between the mobile phone and the laptop computer because these specially designed applications would necessarily be compatible with each other. Therefore, one of ordinary skill in the art would not have been motivated to incorporate the conversion of file formats as described in Ulrich into the system of Kobayashi to promote compatibility at least because the system of Kobayashi does not involve the transmission of attachment files with various electronic file formats to a mobile device to be manipulated by corresponding different software applications.

The Examiner further alleges that the file format conversion discussed in Ulrich would have been appreciated by one of skill in the art as resulting in "less information to be transferred to the mobile device" if implemented in the system of Kobayashi. The sections of Ulrich cited by the Examiner do not provide any teaching that the file format

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conversion discussed reduces the size of files transmitted to the mobile device. Only that it enables the files to be placed in a format compatible with the software installed on the mobile device. In fact, it is just as likely that the new file formats would increase the size of the email attachments transmitted to the mobile device. Therefore, the Examiner has failed to provide evidence that the proposed combination would have been expected to achieve the stated reason for making the modifications. As such, one of ordinary skill would not have been motivated to incorporate the conversion of file formats of Ulrich into the system of Kobayashi to reduce the amount of information transmitted to the mobile device because there is no evidence in the record that the file format conversions discussed in Ulrich would have been expected to have this result.

Thus, the motivation expressly stated by the Examiner (*i.e.*, "so that the received data would be compatible with the mobile device and viewable by the user and less information to be transferred to the mobile device") constitutes legal error. The Examiner has not articulated any other grounds for supporting the alleged obviousness of the proposed combination of Kobayashi with Ulrich. For at least this reason the rejection of claims 21 and 38 (and their dependent claims) constitutes legal error and must be reversed.

B.   CLAIMS 24 AND 41

The rejection of claims 24 and 41 constitutes legal error. For example, the standing rejection of claims 24 and 41, which is based on a proposed combination of Kobayashi and Criss, is improper because the cited portions of Kobayashi and Criss (1) do not teach or suggest all of the features of the claimed invention, and (2) Criss is non-analogous art.

   1.   **The Examiner Has Not Demonstrated That Kobayashi, Ulrich, And Criss Teach Or Suggest All Of The Features Of The Claimed Invention.**

To properly reject claims 24 and/or 41, the Examiner must demonstrate that cited portions of Kobayashi, Ulrich, and Criss teach or suggest each and every feature of the claimed invention. Kobayashi, Ulrich, and Criss fail to teach or suggest, for example, the features of **wherein the profile of the wireless client device comprises at least**

one of a feature of the wireless client device or a device type of the wireless client device, as is recited *inter alia* in each of claims 24 and 41.

The Examiner acknowledges that Kobayashi and Ulrich fail to teach or suggest this feature, but alleges that Criss teaches that a server holds "the Version ID of software, memory, and mode" of a wireless device at FIG. 5a (reproduced below) [Answer, p. 10]. Criss discloses that FIG. 5a illustrates the type of information stored on a server regarding individual wireless devices [c. 10, ll. 1-19]. However, this information does not represent "a feature of the wireless client device or a device type of the wireless client device." Instead, this information represents information about the software on the wireless client device (*e.g.*, version of the software, memory required by the software, and mode of the software).

Fig. 5a

Package Name	Version ID, Req. Memory, Mode	File Name	Mobile Ter. Path	FTP Path	Type	ROM/RAM

Whether or not Criss teaches that information related to the software loaded onto the wireless device (*e.g.*, at c. 12, ll. 55-62) is stored by a server is irrelevant, as the software loaded onto a wireless device is neither a "feature of the wireless client device" nor a "device type". As such, the cited sections of Kobayashi and Criss do not teach or suggest **the profile of the wireless client device comprises at least one of a feature of the wireless client device or a device type of the wireless client device.** For at least this reason the rejections of claims 24 and 41 based on the cited sections of Kobayashi, Ulrich, and Criss are erroneous and must be reversed.

2.   **Criss is non-analogous art for the purposes of the instant application.**

Criss is non-analogous art for the purposes of claims 24 and 41 [Appeal Brief, pp. 15-18]. The Examiner alleges that the Appellants' field of endeavor " relates [sic] wireless device access server via network [sic]" [Answer, p. 11]. The Examiner further alleges that since Criss "teaches a system between at least the mobile device and a host computer (see abstract) over a network for information exchanging," Criss is in the

same field of endeavor [*id.*]. This misapplication of the test for determining whether a reference is analogous art constitutes legal error.

The Examiner's interpretation of the "field of endeavor" for the instant application and Criss is so expansive that it would apply to virtually any system in which a client interacts with a server over a wireless network. Expansion of the definition of Appellants field of endeavor beyond that which is recited in the claims and disclosed in the specification constitutes legal error [the specification, p. 1, ll. 4-7].

Application of the proper two-step legal analysis frequently demonstrates that references, which might appear relevant to (or have something in common with) a claimed invention, are not analogous and therefore may not be properly considered. The Federal Circuit has frequently confirmed this. For example, it has held that the art of petroleum extraction is not analogous to the art of petroleum storage despite both being in the petroleum industry [*In re Clay*, 966 F.2d 656, 659-60 (Fed. Cir. 1992)]. Fasteners for garments are not analogous to fasteners for a hose clamp [*In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992)]. Paper stapling is not analogous to surgical stapling [*U.S. Surgical Corp. v. Hospital Prods. Int'l Pty., Ltd.*, 701 F. Supp. 314, 334 (D. Conn. 1988)]. Single in-line memory modules (SIMMs) for an industrial controller are not analogous to SIMMs for personal computers [*Wang Labs., Inc. v. Toshiba Corp.*, 993 F.2d 858, 864 (Fed. Cir. 1992)]. Railway car brakes are not analogous to automotive vehicle brakes [*SAB Industri AB v. The Bendix Corp.*, 199 USPQ 95, (E.D. Va. 1978)].

For at least the foregoing reasons, it is clear that the Examiner has not proven an essential element of the obviousness test, *i.e.*, that Criss is within the scope and content of the prior art. As a result, Criss cannot be properly considered in an obviousness analysis. Accordingly, the rejection of claims 24 and 41 under 35 U.S.C. § 103(a) should therefore be reversed.
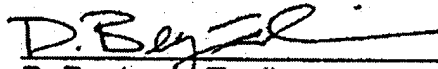
CONCLUSION

For at least the foregoing reasons, Appellants respectfully request that the rejection of each of claims 21, 22, 24-30, 32-39, and 41-44 be reversed.

Date: February 23, 2009

Respectfully submitted,

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